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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,774	01/27/2004	Newton James Smith JR.	AUS920030902US1	2460
7590	08/13/2004			
Darcell Walker Suite 250 9301 Southwest Freeway Houston, TX 77074			EXAMINER WALSH, DANIEL I	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/765,774

Applicant(s)

SMITH ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 27 January 2004.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 and 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Golasinski et al. (US 2003/0097332).

Re claims 1 and 2 Golasinski et al. teaches displaying a list of payees to a customer in response to a customer request to pay a bill at the remote terminal location, determining customer payment information, receiving a payment instrument (check) from the customer, submitting payment to payee, and sending customer a payment confirmation receipt (FIG. 2A/2B). Re claim 3, the limitations are taught (paragraph [0028]). Re claims 4-5 a customer is prompted to submit payment account information in the form of a bill (paragraph [0029]). Re claim 6, , Golasinski et al. teaches prompting the customer to select a payment plan after submitting the statement (step 25, FIG 2B), where paying the full or partial amount is interpreted as a payment plan.

Re claims 10-16, the limitations are discussed above re claims 10-16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 7-9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golasinski et al. further in view of Martin, JR. et al. (US 2001/0001148).

The teachings of Golasinski et al. have been discussed above. Re claim 7, the Examiner notes that Golasinski et al. teaches electronic payment plans (FIG. 2B), but is silent to a manual payment plan.

The Examiner notes that manually payment plans, essentially depositing of checks for bill payment is well known and conventional in the art. Typically, a check for a bill payment, along with the bill itself, is dropped off/deposited at an ATM/kiosk, and later fetched and processed by a person (hence manual). Specifically, Martin, JR. et al. teaches such limitations

(paragraph [0007]). It is understood that notification is provided to an operator of the terminal about the pending submission of a paper transaction, as electronic records are recorded.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Golasinski et al. with those of Martin, JR. et al.

One would have been motivated to do this to combine well known/obvious means of bill payment, in order to provide more choices to the user. Such modification is well within the skill in the art, as both means are common, and produce predictable results, and it is believed that their combination, motivated by providing more choices/options, would produce predictable results as well. Though the prior art is silent to selecting a plan after the submitting step, it is obvious that a selection is required between choices. Simply prompting a user for such a selection is well within the skill in the art, and the timing of the prompting is a matter of design variation, determined by the system being implemented.

Re claims 17-19, the limitations have been discussed above re claims 7-9.

4. Claims 10 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Golasinski et al./Martin, JR. et al., further in view of Riach et al. (US 5,751,842).

The teachings of Golasinski et al./Martin, JR. et al. have been discussed above.

Golasinski et al./Martin, JR. et al. are silent to the receipt including a copy of the scanned check image, the name of the payee, the amount of the payment, and date/time of the payment.

Riach et al. teaches a self service terminal that accepts a user document for processing such as paying a bill (abstract), that prints a receipt including a copy of the transaction, printed image of significant portions of the document, name of the payee, amount of the payment, and the data and time of the payment (FIG. 7). Though Riach et al. teaches only significant parts of

the document, not the whole document, it would have been obvious to print the whole document, to provide a record (complete) for the users records. Accordingly, it is clear from the specification that FIG. 7 is also intended to include bill payment transactions.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Golasinski et al./Martin, JR. et al. with those of Riach et al.

One would have been motivated to do this in order to provide a detailed receipt of the transaction for records.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Dutta et al. (US 2002/0152165), which teaches scanning a bill, obtaining an electronic version, and electronic payment, Kamata et al. which teaches bill paying at a terminal and storing an image file, Cooley et al. (US 5,616,902) which teaches inserting a bill into a terminal and paying with cash, Antognini et al. (US 2002/0023055) which teaches bill payment, Garrison et al. (US 6,327,577), which teaches bill payment with account number scheming, Gustin et al. (US 6,012,048 and US 5,897,625) which teach bill payment through an ATM, and Barone (WO 98/07119) which teaches bill paid to an ATM electronically, and including printing a check.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The

examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
DW  
8/4/04

  
KARL D. FRECH  
PRIMARY EXAMINER